



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,910	02/06/2001	Robyn Joyce Russell	50179-087	3696

7590

05/10/2005

McDERMOTT, WILL & EMERY  
600 13th Street, N.W.  
Washington, DC 20005-3096

EXAMINER

RAO, MANJUNATH N

ART UNIT PAPER NUMBER

1652

DATE MAILED: 05/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/776,910

Applicant(s)

RUSSELL ET AL.

Examiner

Manjunath N. Rao, Ph.D.

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-11 and 14-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9, 14-18 and 30 is/are allowed.
- 6) ☒ Claim(s) 10, 11 and 19-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 1652

### **DETAILED ACTION**

Claims 9-11, 14-30 are currently pending and are present for examination. Claims 9-11, 14-30 are now under consideration.

Applicants' amendments, arguments and the Declaration filed under Rule 1.132 filed on 2-15-05, have been fully considered and are deemed to be persuasive to overcome the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. Specifically, Examiner has withdrawn the previous rejection held under 35 U.S.C. 112, 1<sup>st</sup> paragraph without fully acquiescing with applicant's arguments but based on his own determination of per cent identity between the sequences filed in the case and the information provided in the Declaration filed under Rule 1.132.

### ***Election/Restrictions***

Claims 9, 14-18, 30 are all directed to an allowable product. Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), claims 10-11, 19-29, directed to the process of making or using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, are now subject to being rejoined. Claim 10-11, 19-29 are hereby rejoined and fully examined for patentability under 37 CFR 1.104.

Since all claims previously withdrawn from consideration under 37 CFR 1.142 have been rejoined, the restriction requirement made in the Office action mailed on 2-26-03 is hereby withdrawn.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21, 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 21 and 27 recite the phrase “or a sequence which hybridizes thereto..”. the metes and bounds of the above phrase specifically with the term “hybridizes” in the context of the above claims are not clear to the Examiner. It is not clear as to what hybridization conditions are encompassed in the above phrase. Examiner has broadly considered the phrase to include all or any hybridization conditions for examination purposes.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10-11, 19-29 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method of eliminating or reducing the concentration of organophosphate pesticide residues in a contaminated sample comprising contacting the sample with an enzyme having an amino acid sequence SEQ ID NO:8 or such an enzyme encoded by either SEQ ID NO:1, 3, or 5 and having a amino acid substitution at position 251, wherein the substituted amino acids are either Leu, Ser, Ala, Ile, Val, Thr, Cys, Met or Gly and capable of hydrolyzing organophosphates, does not reasonably provide enablement for such a method in which any such enzyme encoded by a polynucleotide comprising a nucleotide sequence having

Art Unit: 1652

at least 60%, 80% or 95% identity with LcαE7 or a polynucleotide sequence which simple hybridizes to SEQ ID NO:1, 3 or 5 (claims 21, 27) under any or all hybridization conditions, is used. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Factors to be considered in determining whether undue experimentation is required, are summarized in *In re Wands* (858 F.2d 731, 8 USPQ 2nd 1400 (Fed. Cir. 1988)) as follows: (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claim(s).

Claims 10-11, 19-29 are so broad as to encompass a method of using any organophosphate degrading enzyme encoded by a polynucleotide comprising a nucleotide sequence having at least 60%, 80% or 95% identity with LcαE7 or a polynucleotide sequence which simple hybridizes to SEQ ID NO:1, 3 or 5 (claims 21, 27) under any or all hybridization conditions wherein the encoded enzyme has an amino acid substitution at position 251, wherein the substituted amino acids are either Leu, Ser, Ala, Ile, Val, Thr, Cys, Met or Gly. The scope of the claims is not commensurate with the enablement provided by the disclosure with regard to the extremely large number of said enzymes broadly encompassed by the claims including variants, mutants and recombinants. Since the amino acid sequence of a protein determines its structural and functional properties, predictability of which changes can be tolerated in a protein's amino acid sequence and obtain the desired activity requires a knowledge of and

Art Unit: 1652

guidance with regard to which amino acids in the protein's sequence, if any, are tolerant of modification and which are conserved (i.e. expectedly intolerant to modification), and detailed knowledge of the ways in which the proteins' structure relates to its function. However, in this case the disclosure is limited to the nucleotide and encoded amino acid sequence of only one said enzyme comprising the specific amino acid changes mentioned above. It would require undue experimentation of the skilled artisan to make and use the claimed polypeptides. The specification is limited to teaching the making and using amino acid sequence encoded by SEQ ID NO:1, 3, or 5 wherein said encoded sequence differs from SEQ ID NO:8 in having an amino acid substitution at position 251, wherein the substituted amino acids are either Leu, Ser, Ala, Ile, Val, Thr, Cys, Met or Gly and wherein said polypeptide continues to have organophosphate hydrolyzing activity but provides no guidance with regard to the making of variants and mutants for use in the methods as claimed. In view of the great breadth of the claim, amount of experimentation required to make the claimed polypeptides, the lack of guidance, working examples, and unpredictability of the art in predicting function from a polypeptide primary structure (e.g., see Ngo et al. in *The Protein Folding Problem and Tertiary Structure Prediction*, 1994, Merz et al. (ed.), Birkhauser, Boston, MA, pp. 433 and 492-495, Ref: U, Form-892), the claimed invention would require undue experimentation. As such, the specification fails to teach one of ordinary skill how to use the full scope of the polypeptides encompassed by this claim.

While recombinant and mutagenesis techniques are known, and it is routine in the art to screen for multiple substitutions or multiple modifications as encompassed by the instant claims, the positions within a protein's sequence where amino acid modifications can be made with a reasonable expectation of success in obtaining the desired activity/utility are limited in any

Art Unit: 1652

protein and the result of such modifications is unpredictable. In addition, one skilled in the art would expect any tolerance to modification for a given protein to diminish with each further and additional modification, e.g. multiple substitutions.

The specification does not support the broad scope of the claims which encompasses the use of polypeptides encoded by any or all LcαE7 polynucleotides comprising all modifications and fragments of any organophosphate hydrolyzing enzyme, because the specification does not establish: (A) regions of the protein structure (except for the amino acid position 251) encoded by LcαE7 polynucleotide which may be modified without effecting activity; (B) the general tolerance of above enzymes encoded by LcαE7 polynucleotide to modification and extent of such tolerance; (C) a rational and predictable scheme for modifying any amino acid residues in the polypeptide encoded by LcαE7 polynucleotide with an expectation of obtaining the desired biological function; and (D) the specification provides insufficient guidance as to which of the essentially infinite possible choices of all those polynucleotides which hybridize to LcαE7 polynucleotide under any or all hybridization conditions is likely to be successful in encoding said polypeptide.

Thus, applicants have not provided sufficient guidance to enable one of ordinary skill in the art to make and use the claimed invention in a manner reasonably correlated with the scope of the claims broadly including enzymes encoded by encoded by LcαE7 polynucleotides including variants, mutants and recombinants. The scope of the claims must bear a reasonable correlation with the scope of enablement (*In re Fisher*, 166 USPQ 19 24 (CCPA 1970)). Without sufficient guidance, determination of enzymes having the desired biological characteristics is unpredictable and the experimentation left to those skilled in the art is

Art Unit: 1652

unnecessarily, and improperly, extensive and undue. See *In re Wands* 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir, 1988).

Claims 10-11, 19-20, 22-26, 28-29 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 10-11, 19-20, 22-26, 28-29 are directed to a method of eliminating or reducing the concentration of organophosphate pesticide residues in a contaminated sample comprising contacting the sample with an enzyme having an amino acid sequence encoded by a polynucleotide comprising a nucleotide sequence having at least 60%, 80% or 95% identity with L $\alpha$ E7, or a polynucleotide encoding the polypeptide RM-8Con, M $\alpha$ E7. Claims 10-11, 19-20, 22-26, 28-29 are rejected under this section of 35 USC 112 because the claims are directed to a genus of polypeptides including modified polypeptide sequences, modified by at least one of deletion, addition, insertion and substitution of an amino acid residue and encoded by polynucleotides that have not been disclosed in the specification. No description has been provided of all the polynucleotides which encode the polypeptide sequences encompassed by the claim. No information, beyond the characterization of SEQ ID NO: 1, 3, and 5 has been provided by applicants which would indicate that they had possession of the claimed genus of modified polypeptides. The specification does not contain any disclosure of the structure of all the L $\alpha$ E7 polynucleotide sequences or polynucleotide sequences encoding all RM-8Con, M $\alpha$ E7 polypeptides including mutants, variants and recombinants within the scope of the genus



Art Unit: 1652

required for the claimed method. The genus of polynucleotides for use in the claimed method is a large variable genus which can have a wide variety of structures. Therefore many structurally unrelated polynucleotides are encompassed for use within the scope of these claims. The specification discloses only a three species of the genus of polynucleotides for use in claimed method without any evidence that these are representative of the whole genus which is insufficient to put one of skill in the art in possession of the attributes and features of all species within the genus. Therefore, one skilled in the art cannot reasonably conclude that applicant had possession of the claimed invention at the time the instant application was filed.

Applicant is referred to the revised guidelines concerning compliance with the written description requirement of U.S.C. 112, first paragraph, published in the Official Gazette and also available at [www.uspto.gov](http://www.uspto.gov).

### ***Conclusion***

Claim 9, 14-18, 30 are allowable.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 1652

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 571-272-0939. The Examiner can normally be reached on 7.00 a.m. to 3.30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306/9307 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.



Manjunath N. Rao, Ph.D.  
Primary Examiner  
Art Unit 1652

May 5, 2005